



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of _____ Date : October 28, 2005
JILL E. BARAD et al. Our Docket : MAT 3C7B
Serial No. : 09/804,664 Group Art : 3712
Filed : March 12, 2001 Examiner : Urszula Cegielnik
For : PERSONALIZED TOY AND METHOD FOR MANUFACTURING
AND DELIVERING THE SAME

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Sir:

BRIEF FOR APPELLANTS

This is an appeal from the Examiner's final rejection of claims 6, 13, 20-25 and 27-34 in the final Office action dated February 9, 2005.

I. REAL PARTY IN INTEREST

Mattel, Inc., a Delaware corporation having its principal place of business at 333 Continental Boulevard, El Segundo, California 90245-5012, U.S.A., is the assignee of U.S. Patent Application Serial No. 09/804,664 and the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

III. STATUS OF CLAIMS AND GROUNDS FOR REJECTIONS

Claims 6, 13, 20-25 and 27-34 are presently pending in the application and stand rejected under both 35 U.S.C. § 102(b) and § 103(a) as being anticipated by, and obvious over, U.S.

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Patent No. 3,144,932 to Zerbo. Additionally, claims 6, 20, and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejections of the pending claims are traversed. Thus, all presently pending claims are on appeal.

IV. STATUS OF AMENDMENTS

The present application was filed on March 12, 2001 with original claims 1-3, as a division of and claiming priority to U.S. Patent Application Serial No. 09/183,323 filed October 30, 1998, which issued on March 27, 2001 as U.S. Patent No. 6,206,750, of Jill E. Barad, Jeanette Corcuera, Greg Vineyard, Darian Pasterski, Joe Scully, John Watson, Roy Kaneshiro, Brian Channell, Jean Chu, Nancie Martin, Simon Cheung Shu Keun, and Li Tak Chee.

New claims 4-17 were added in applicants' June 3, 2001 preliminary amendment.

Applicants' December 17, 2002 response to the third Office action (made final) included amendments after final rejection, but these amendments were indicated not to have been entered in an Advisory Action dated January 2, 2003.

In applicants' June 3, 2003 response to the fourth Office action, claims 1, 4, 6, 10, and 13 were amended, and new claims 18-28 were added.

In applicants' December 15, 2003 response to the fifth Office action (made final), claims 1-5, 7-12, and 14-17 were canceled without prejudice.

In applicants' June 3, 2004 response to the sixth Office action, claims 6 and 13 were amended, claims 18, 19, and 26 were canceled without prejudice, and new claims 29-24 were added.

No additional amendments are pending.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claims of the present application are directed to packaged, personalized toys, and packages for displaying personalized toys. More particularly, independent claims 6 and 34 both recite a customer-defined, packaged, personalized toy. Independent claim 29 recites a packaged toy, and independent claim 13 recites a package for displaying a personalized toy. The remaining pending claims depend, either directly or indirectly, from independent claims 6, 13, 29, and 34. The various recitations of the independent claims are discussed in greater detail in the paragraphs below.

The personalized toy of claim 6, for example, comprises a package having an aperture, a personalized toy in the package, and printed material supported on the package. The claim also recites that the printed material, which includes customer-defined identifying material, including a customer-defined intended recipient, is separate from the toy and supported on the package such that the identifying material is visible through the aperture of the package. Claim 6 further recites that the aperture is smaller than the printed material (as indicated, for example, in Figs. 2 and 3).

Independent claim 34 recites a customer-defined, packaged, personalized toy comprising a package, a personalized toy in the package, customer-defined identifying material separate from the toy and supported on the package, and an aperture in the package positioned so that at least a portion of the identifying material is visible through the aperture, wherein the visible portion of the identifying material blocks the aperture, preventing the viewing of the personalized toy from the exterior of the package.

Independent claim 29 recites a packaged toy comprising a personalized toy, customer-defined identifying material separate from the toy and adapted to be customized according to

specifications created by a customer, and a package enclosing the personalized toy and the customer-defined identifying material. The claim recites that the customer-defined identifying material includes an indication of a customer-defined intended recipient, and also recites that the package has a flap covering at least a portion of the personalized toy that is adapted to support the customer-defined identifying material, with at least a portion of the identifying material being visible from the exterior of the package.

Finally, independent claim 13 recites a package for displaying a personalized toy, the package comprising a flap, separate from the toy, the flap having an inside and an outside, the inside of the flap facing the personalized toy, an aperture in the flap, and customer-defined identifying material supported on the inside of the flap. The claim also recites that the customer-defined identifying material includes a customer-defined intended recipient.

Thus, although the independent claims are directed to distinct features of personalized toys and/or packages in which such toys are displayed, there are some limitations common to most or all of the presently pending claims. For example, independent claims 6, 29, and 34 each recite, in part, “*a personalized toy*.” All of the pending claims recite, in part, “*customer-defined identifying material*,” and in each of the presently pending claims except independent claim 34, the customer-defined identifying material includes an indication of a “*customer-defined intended recipient*.”

As described in the specification, a personalized toy, such as a personalized doll, may be configured by a customer prior to its manufacture. The customer may then place an order, at which point the doll is then assembled as a personalized product according to the customer’s selected component configurations.

More specifically, a customer may initially select the configuration of several components of a toy through interactive computer programs (page 2, lines 5-6; page 13, lines 1-4). To do this, a customer may receive information from a display on a computer screen, and input information through an input device such as a keyboard and/or mouse (page 11, lines 8-11; page 13, lines 8-9). The information presented on the display may then change to indicate information inputted by the customer (page 13, lines 9-10).

In particular, a customer viewing images displayed on a computer screen may select configurations of different components by clicking on representational images presented on the computer screen (page 9, lines 3-13). The customer-configurable components are those characteristic of the toy being personalized by the customer via the interactive computer programs. For example, in the disclosed embodiments, the personalized toy is a personalized doll, and the configurable components include a body, for which the customer may select a skin color; a head having a mouth with a customer-selectable shape, eyes with a customer-selected color, hair with a customer-selected style, length, and color; clothing and accessories with a customer-selected fashion; and so forth (page 7, lines 16-19; page 8, lines 3-11). Further, configurations of other components of the doll may be presented for selection by a customer, such as electronic components including customer-selected movement characteristics, audio and/or visual output, and so forth (page 8, lines 17-19).

Although many of the disclosed customer-configurable components are characteristic of dolls, the specification indicates that the invention may include a method to make other types of personalized toys, such as toy vehicles, race sets, construction sets, and games (page 8, lines 1-2).

During component configuration, a customer may also input identifying information (page 14, lines 2-8). The identifying information may include order information such as

information relating to a delivery address (*see, e.g.*, page 16, line 7), and/or information relating to the configuration of the toy, such as a toy name defined by the customer (page 10, lines 1-2), an intended recipient as defined by the customer (*id.*), and so forth.

After a customer selects configurations of the components and provides identifying information, a summary of the personalized toy may be displayed, such as by means of a representational image showing the personalized toy (page 14, lines 13-15). The customer may then initiate an order for the personalized toy with the selected configurations of components (page 15, lines 1-6).

Once an order is initiated, a personalized toy is manufactured according to the customer-selected configurations (page 2, lines 5-11; page 4, lines 11-13; page 7, lines 8-10; page 16, lines 2-6; page 20, line 11 – page 21, line 11; Abstract, lines 2-4; Figs. 5 and 26). During manufacturing and assembly, identifying material may be printed, based on the identifying information and the set of customer-selected configurations of components or attributes (page 16, lines 4-6). The identifying material may include customer-provided information such as the customer's name and customer-defined intended recipient (page 10, line 2), and may be included with additional textual information such as a description of the selected configuration of the toy, a story, a certificate of authenticity, and so forth (page 9, line 19 – page 10, line 2).

The specification indicates that the resulting printed material may be packaged together with the personalized toy in a package, such as a package with one or more apertures, so that some of the printed material is visible through an aperture to create the appearance of a personalized package (page 9, lines 13-17). For example, Fig. 2 shows a personalized toy 10 inside a package 34 that has apertures 36. One aperture (36b) is disposed in a front flap 50, which has tabs 52 adapted to secure printed material 38 within package 34 in a desired position.

Specifically, with additional reference to Fig. 3, printed material 38 is shown in Fig. 2 to be secured such that at least some of the identifying material 42 (a customer-defined toy name 44 and a customer-defined intended recipient 46) is visible through aperture 36b.

VI. ISSUE

1. Whether claims 6, 20, and 21 were improperly rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Whether claims 6, 13, 20-25 and 27-34 were improperly rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,144,932 to Zerbo.
3. Whether claims 6, 13, 20-25 and 27-34 were improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,144,932 to Zerbo

VII. GROUPING OF CLAIMS

Relative to the above issues, appealed claims 6, 20, and 21 stand together in the sense that the rejection of claims 20 and 21 will be overcome when the rejections of claim 6 as being indefinite, and as being anticipated and/or obviated by Zerbo, are withdrawn. Claims 13, 22-25, 27, and 28 stand together in the sense that the rejection of claims 22-25, 27, and 28 will be overcome when the rejections of claim 13 as being anticipated and/or obviated by Zerbo are withdrawn. Similarly, claims 29-33 stand together in the sense that the rejection of claims 30-33 will be overcome when the rejections of claim 29 are withdrawn. Since no claims depend from claim 34, claim 34 stands alone.

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VIII. ARGUMENT

A. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 6, 20, and 21 were rejected under 35 U.S.C. § 112, second paragraph, for setting forth indefinite claim language. The rejection is reproduced below:

Claim 6 recites in the last line, "the aperture (window opening 12) is smaller than the printed material". It is not clear what the scope of the claimed subject matter is. Is not clear how the aperture can be smaller than the printed material.

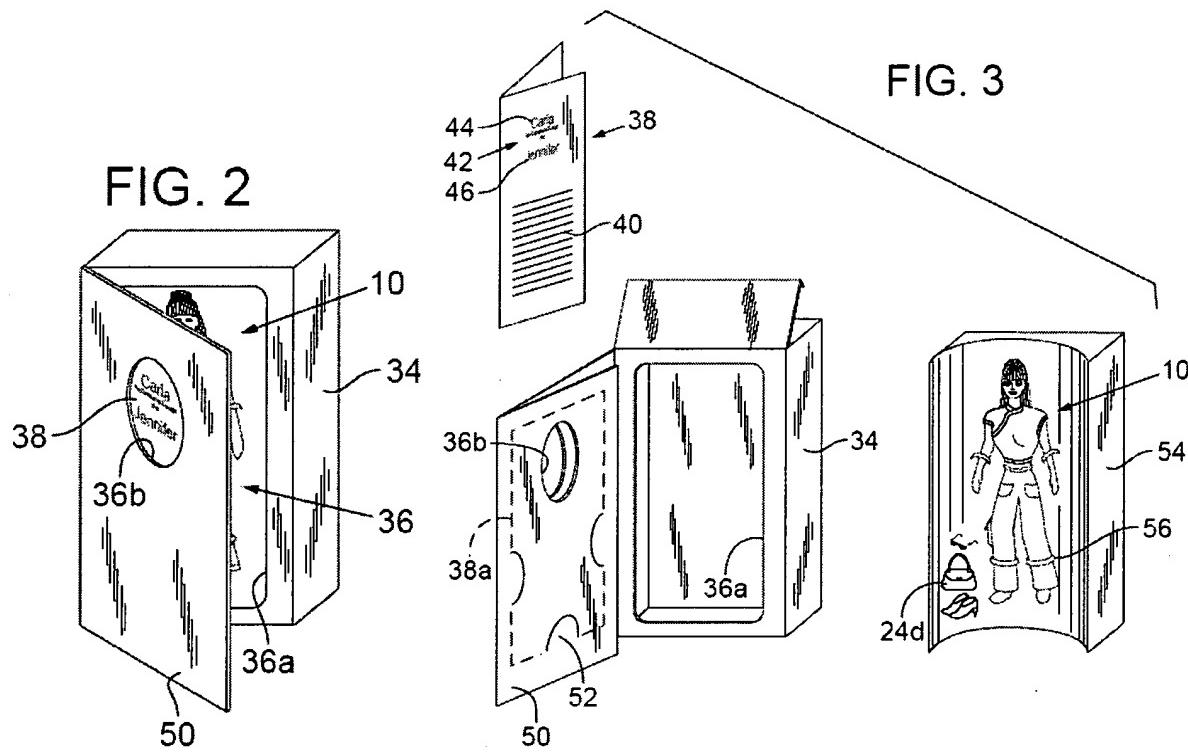
35 U.S.C. § 112, second paragraph, requires that the claims particularly point out and distinctly claim the subject matter which applicants regard as their invention. Acceptability of claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. MPEP 2173.05(b). In this regard, the acceptance of claim language depends on whether the claim language is clear enough to inform the public of the boundaries of what constitutes infringement of the patent. As discussed below, the claim language, read in light of the specification and drawings, provides ample notice to the public of what the applicants regard as their invention.

Initially, applicants note that claim 6 does not recite the quoted language; the parenthetical phrase "*(window opening 12)*" is believed to have been inadvertently included, since the last line of claim 6 recites "*wherein the aperture is smaller than the printed material*" (without the parenthetical phrase).

Thus, the rejections are traversed because one possessing an ordinary level of skill in the art would understand how the aperture can be smaller than the printed material. Essentially, "*the*

aperture is smaller than the printed material" means that the size of the aperture is less than the surface area of the printed material.

Even if the plain meaning is not clear from the language of the claim, the specification clearly indicates what is meant by the recited limitation. For example, Figs. 2 and 3 illustrate a personalized toy 10 inside a package 34 that has apertures 36a, 36b. One aperture (36b) is disposed in a front flap 50, which has tabs 52 adapted to secure printed material 38 within package 34 in a desired position. Figs. 2 and 3 are reproduced below:



Specifically, printed material 38 is shown in Fig. 2 to be secured such that at least some of the identifying material 42 (a customer-defined toy name 44 and a customer-defined intended recipient 46) is visible through aperture 36b. Since the size of aperture 36b is less than the surface area of printed material 38, the language, "*the aperture is smaller than the printed material*," reasonably apprises those of skill in the art, both of the utilization and the scope of the invention, and is as precise as the subject matter permits. *Shatterproof Glass Corp. v. Libbey*

Owens Ford Co., 758 F.2d 613 (Fed. Cir. 1985). Therefore, applicants respectfully submit that the rejection of claim 6 under 35 U.S.C. § 112, second paragraph, and that of claims 20 and 21 which depend therefrom, should be reversed.

B. Rejections Under 35 U.S.C. §§ 102(b) and 103(a) Over Zerbo

1. The Disclosure of U.S. Patent No. 3,144,932 to Zerbo

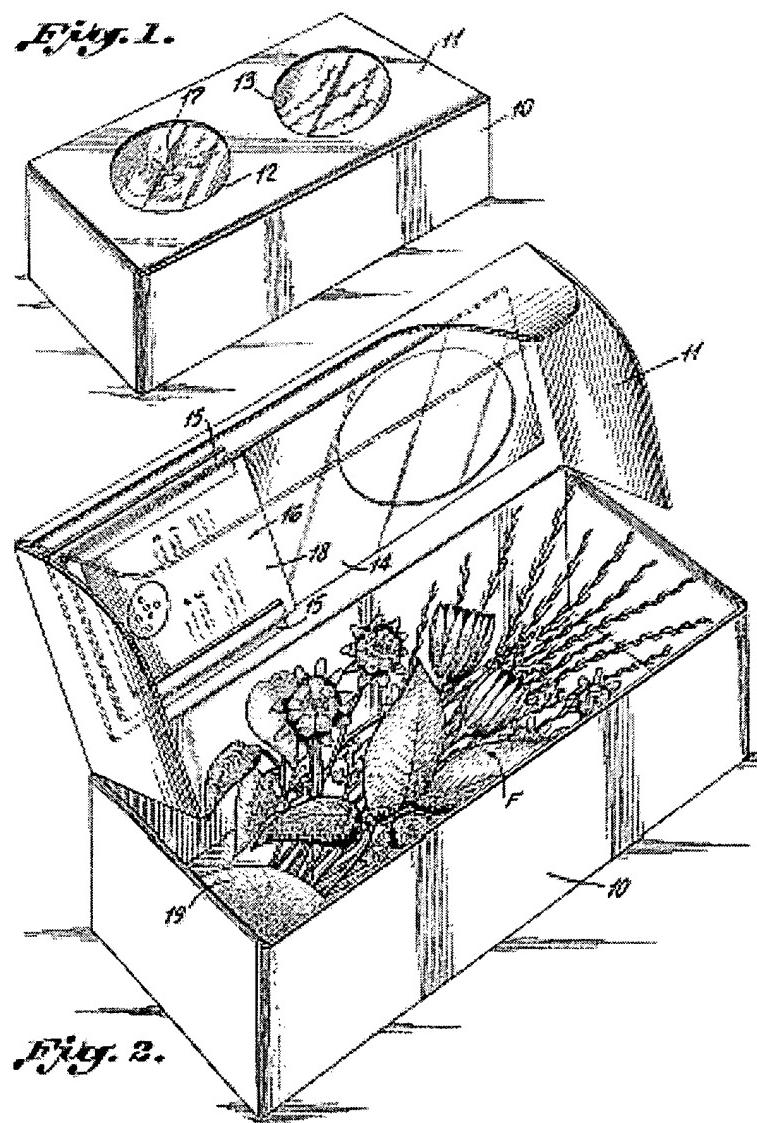
The disclosure of the Zerbo reference, asserted by the Examiner to teach each and every element of all of the presently pending claims, is limited to “do-it-yourself” floral arrangement kits. The kits are described to include several artificial flowers, a block of Styrofoam, and detailed instructions for mounting or “impaling” the flowers in the block.

The “general object” of the configuration of the floral arrangement kits is described in Zerbo as follows: “to facilitate the economical marketing of artificial flowers in special assortments ... and to afford the [customer] flower combinations which may be assembled [with] the attendant satisfaction which normally is experienced only by creative artists in the field” (2:1-8). In other words, the Zerbo reference is directed towards efficiently marketing a do-it-yourself product designed to appease the aesthetic tastes of purchasers who themselves lack the artistic skills (and/or the desire) to create an arrangement of flowers, by providing kits that include all of the necessary materials to enable the customer to assemble an arrangement that has been already been designed “according to the best artistic taste and judgment of a specialist in the field of flower arranging” (1:24-30).

Apart from this reference to the “specialist in the field of flower arranging,” the entirety of Zerbo’s disclosure is directed toward the consumer, and the product with which the consumer is presented *after it has been manufactured and packaged*: the consumer is presented with a “large number” of a “diverse” number of such predetermined floral arrangements from which to

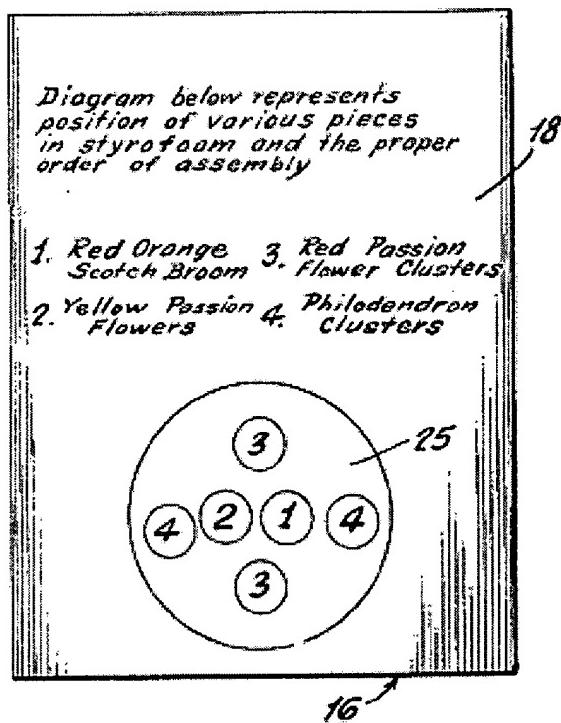
choose the one that appeals to his or her taste (1:31-35); the consumer is taught how to assemble a predetermined arrangement "by following the instructions for mounting the flowers contained in the box" (2:32-33); the consumer, in so doing, attains the desired "ornamental" and "esthetic" effects of having created the arrangements (1:29-30; 1:45-46; 2:6-8). Zerbo is completely silent with regard to consumer interaction with the product prior to its manufacture, packaging, and delivery.

The various structural components of the Zerbo kits are illustrated in Figs. 1 and 2 of Zerbo, reproduced below:



The kit includes a box-like container 10 with a foldably attached cover 11 that has two openings 12, 13 (Fig. 1; Fig. 2; 2:43-58). The inside of the cover has a pocket 15 adjacent one opening, so that one side of a card 16 placed in the pocket is visible from the exterior of the container when the cover is closed (Fig. 1; Fig. 2; 2:59-3:3). The side of the card visible from the exterior bears a pictorial illustration 17 of the floral arrangement (Fig. 1; 2:60-64), and the other side 18 bears instructions for assembling the floral arrangement the kit is designed to replicate (Fig. 3; 3:12-13). The card can also include a name designation for the arrangement (2:4-5).

The instructions provided in the Zerbo reference are very specific: the outline of a block 19 of Styrofoam (included with the kit) serves as a visual “map”, upon which is indicated the relative position and orientation of each included floral component, as well as the order in which each component is to be affixed to the foam block (3:22-49). Fig. 3 illustrates instructions 18 on card 16, and is reproduced below:



In sum, the customer himself has no input into the product prior to manufacture or purchase. Indeed, the only “input” the customer has, if any, relates to the final arrangement of the purchased kit: Zerbo indicates that the customer may modify the arrangement during assembly “if he wishes to assert his own artistic talents in the area” (3:55-56). All other aspects of the kit and kit components are provided by the manufacturer and incorporated into the kit prior to being offered to the consumer in the marketplace.

Thus, as disclosed, Zerbo provides a kit with components and instructions to assemble a predetermined floral arrangement, and completely fails to disclose several features of the rejected claims. As discussed in more detail below, Zerbo fails to disclose a toy, much less a personalized toy, or any customer-defined identifying material (such as a customer-defined intended recipient).

2. The Pending Claims Include Elements Not Disclosed by Zerbo

As mentioned above, the pending claims include independent claims 6, 13, 29, and 34, that are directed collectively to packaged toys and packages for displaying personalized toys, and individually to distinct features of personalized toys and/or packages in which such toys are displayed. However, all of the presently pending claims recite some limitations or elements that are not disclosed by Zerbo. Thus, the following discussion is presented in an element-by-element, rather than a claim-by-claim, analysis. In the paragraphs below, several such exemplary limitations are presented, any one of which itself suffices to defeat the Examiner’s rejection of the independent claim or claims that include the element under 35 U.S.C. § 102(b), and the rejections of any and all claims that depend therefrom.

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a. Zerbo fails to disclose at least the element of “toy”

Independent claims 6, 29, and 34 each recite, in part, a “toy.” Zerbo does not disclose a toy. Instead, Zerbo discloses flower arranging kits that include artificial flowers, a block of foam, and instructions for mounting the flowers in the foam.

Indeed, Zerbo fails to mention the word “toy” anywhere in its disclosure, or include or even discuss related concepts such as “play,” “child,” “fun,” “game,” and other terms. Rather, the disclosure of Zerbo is entirely concerned with economical marketing of floral arrangement kits, speaking, for example, of “accentuating the esthetic effects produced by [an] assortment of artificial flowers” (3:14-15). Even the terms used by the Examiner in the Office action to describe the flowers (“flowers F, for example, which can be used for amusement or diversion”) find no support in the Zerbo reference.

Moreover, Zerbo repeatedly describes the artificial flowers of the kits as having stems that may be “impaled” into a block of foam (1:20; 3:30; 3:52; 3:74), a concept that is inconsistent both with the idea of a “toy” as presented in the specification, and with the Examiner’s own interpretation of the flowers as being something “which can be used for amusement or diversion.”

Nevertheless, the Examiner contends that the artificial flowers of the Zerbo reference are a toy. This assertion, however, is incorrect. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. MPEP § 2111; *see also In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). When the term “toy” is given its ordinary meaning to one skilled in the art and as set forth in the specification, it is clear that Zerbo fails to disclose at least this element. Moreover, when considering the lengthy prosecution

history of the pending application, the assertion that the artificial flowers of Zerbo comprise a “toy” is completely inconsistent with the Examiner’s demonstrated interpretation of the term.

Beginning with the specification, the text and the drawings disclosing personalized toys and packages for displaying such toys discuss and illustrate a specific example of personalized toy: a personalized doll that resembles a young girl. The specification is replete with references to a doll and various doll components and characteristics, but also indicates that “other types of personalized toys” may include “toy vehicles, race sets, construction sets, and games” (page 8, lines 1-2).

Thus, the specification includes five examples of a “toy,” all of which reflect a standard meaning of the term to refer to an object for children to play with.

Also, the specification also specifically incorporates by reference several U.S. patents that disclose toys. For example, U.S. Patent Nos. 5,141,466 and 5,468,172 also use the term “toy” with reference to dolls. U.S. Patent No. 5,279,514 uses the term with reference to teddy bears or other stuffed animals (*see, e.g.*, Abstract), and U.S. Patent No. 5,387,107 uses the term with reference to a story book (*see, e.g.*, 1:18).

Story books, teddy bears, and stuffed animals, are also examples of “toys” as the term is generally understood.

Moreover, the assignee of the presently pending U.S. Patent Application is currently the largest toy manufacturer in the U.S., and enjoys a reputation as a worldwide provider of toys for children earned by several decades of producing and distributing toys, including several globally recognized toy product lines including Barbie dolls and toys, Matchbox and HotWheels toy vehicles and accessories, Fisher-Price infant toys and childrens’ playsets, and several others.

Thus, the ordinary meaning of the term “toy” to one skilled in the art is consistent with the meaning commonly associated with the term: an object for children to play with.

This meaning is further supported by the prosecution history of the application, in which the Examiner has repeatedly demonstrated an interpretation of the term “toy” that is consistent with the ordinary meaning as discussed above, by citing a children’s plaything in every other reference mentioned in the various Office actions issued in connection with this application. For example, the second and third Office actions (dated April 24, 2002 and August 27, 2002, respectively) included rejections over U.S. Patent No. 5,282,766 to Fleet in view of Zerbo. Fleet was cited to disclose a toy in Fig. 1, which is explained in the Fleet reference to be “an example of a toy fish 10” (Fleet 2:12), and is shown in the several figures to be a fish-shaped aquatic toy. Although Zerbo was cited as a reference in support of the rejections, the reference was not cited to disclose a toy in these Office actions.

The fourth and fifth Office actions (dated March 3, 2003 and August 15, 2003, respectively) cited U.S. Patent No. 5,370,223 to Leicht, which was asserted to disclose a toy 22. The cited toy is explained and illustrated in the Leicht reference to be a model vehicle 22 (*see, e.g.*, Leicht 3:57-58). The sixth Office action (dated February 3, 2004) indicated that the allowance of pending claims 6, 13, 18-28 was withdrawn and included rejections over U.S. Patent No. 6,030,274 to Kaplan. The Kaplan reference was cited to disclose a toy 12, explained in Kaplan as follows: “toy 12 preferably comprises a plush toy animal” (Kaplan 3:52). The various figures of Kaplan illustrate a teddy bear.

Thus, the Examiner has demonstrated her understanding of the term “toy,” by citing references that include such examples of children’s playthings as Fleet’s aquatic toy fish,

Leicht's model vehicle, and Kaplan's teddy bear, to be consistent with the ordinary meaning of the term to one skilled in the art.

Simply put, the claims recite a commonly-used term with a generally accepted meaning: an object for children to play with. Examples consistent with this meaning are presented either directly in the application itself (*i.e.*, a doll, toy vehicles, race sets, construction sets, and games) or indirectly via the documents incorporated by reference (*i.e.*, teddy bears or other stuffed animals, story books). The context surrounding the application also demonstrates that the generally accepted meaning is also the ordinary meaning to one skilled in the art. Also, the Examiner has impliedly accepted this meaning by citing examples consistent with this meaning in every other reference cited in the prosecution of this application.

Against this backdrop, the Examiner offers a construction of the term to somehow include artificial flowers in a do-it-yourself flower-arranging kit. The assertion that Zerbo discloses a toy, therefore, finds support nowhere in the specification, the prosecution history, or in the Zerbo reference itself.

In the Office action, the Examiner provides explanatory text accompanying the citation of the structure in Zerbo asserted to be a toy. The language used by the Examiner is that

Zerbo discloses ... a personalized toy (*flowers F, for example, which can be used for amusement or diversion ...*

(page 3, lines 2-3; emphasis in original).

By providing an explanation in support of this interpretation, the Examiner is either consciously urging an inconsistent use of the term “toy” to support the rejections, or is simply providing helpful context. In either case, however, the language “*which can be used for amusement or diversion*” appears to concede that Zerbo does indeed fail to describe a “toy,” by offering something that is not actually a “toy,” but which *may* be used in the suggested manner.

As such, the language indicates that the rejection is based on speculation about what Zerbo *may* disclose, with the entirety of Zerbo failing to disclose or suggest the structure that the Examiner relies upon the reference to provide. Such speculation is an inappropriate basis upon which to ground a rejection under 35 U.S.C. § 102(b), given that a reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the art in the field of the invention in possession of it.¹

Accordingly, for at least the aforementioned reasons, applicants submit that the rejection should be withdrawn from independent claims 6, 29, and 34, and from their dependent claims 20, 21, and 30-33.

b. Zerbo fails to disclose at least the element of “*a personalized toy*”

Independent claims 6, 29, and 34 each recite, in part, a “*personalized toy*.” The Examiner contends that the flowers F of Zerbo comprise a personalized toy. This assertion, however, is incorrect. As described above, flowers F are not a toy, and thus applicants reiterate the above arguments in support of the withdrawal of the rejections. However, even conceding for the sake of this section that the specification, prosecution history, and the disclosure of Zerbo itself may be ignored and the term “toy” may be construed to include artificial flowers, when the term “personalized” is given its ordinary meaning to one skilled in the art and as set forth in the specification, it is clear that Zerbo fails to disclose at least this element.

The term “*personalized toy*” is used in the specification to indicate, in the general sense, a toy possessing some degree of personalization. More specifically, as explained in more detail above, the specification is replete with references to a customer interacting via computer programs to select configurations of components and otherwise personalize a toy doll prior to its

¹ See *In re Spada*, 15 USPQ2d 1655 (Fed. Cir. 1990).

manufacture and shipment. Also, as described in the Background and Summary of the Invention several “patents were discovered disclosing what could be described as personalized toys …” (page 1, line 15). Thus, in context of the specification, a “*personalized toy*” refers a toy manufactured to include one or more components configured by a customer prior to its manufacture and delivery to a customer.

Zerbo fails to teach or even suggest this element. Instead, Zerbo discloses flower arranging kits that include artificial flowers, a block of foam, and instructions for “impaling” the flowers in the foam. Zerbo describes that the invention facilitates bulk marketing of flower-arranging kits in a wide selection of flower combinations, each combination having been arranged by a “specialist in the field of flower arranging” so that a purchaser may choose and assemble the kit, according to the included instructions, to achieve the “attendant satisfaction which normally is experienced only by creative artists in the field” (1:10-16; 2:1-8). Perhaps most importantly with respect to this element, however, Zerbo is silent with regard to customer interaction with the product prior to its manufacture and packaging.

In other words, there is no personalization in the flower arranging kits. Rather, each kit is marketed to a generic customer base, and is designed to instruct the consumer who happens to purchase it to specifically reproduce a floral arrangement designed by a professional (1:23-26). Nothing in Zerbo implies that the design of any of the floral arrangements of the kits is done with any degree of personalization for a specific person, or that a customer configures any component of the flower-arranging kit prior to its manufacture and delivery. Rather, Zerbo describes the availability of a wide variety of kits, each including components and instructions to assemble different floral arrangement “to meet the tastes and desires of the purchasing public” (2:43-45).

The Zerbo flower kits are produced in bulk to allow a customer to purchase and assemble one of a variety of predetermined floral arrangements.

Applicants presented this argument in a response to the first Office action dated October 22, 2001, noting that “Zerbo only discloses a container intended for generic, non-personalized flowers.” However, the Examiner failed to address this argument in the second Office action, instead citing another reference (U.S. Patent No. 5,282,766 to Fleet) asserted to disclose the element. Incidentally, Zerbo was also cited in the second Office action, but *not* to disclose “a personalized toy.” As such, applicants submit that the Examiner has impliedly conceded that Zerbo fails to disclose this element. Regardless, for at least the aforementioned reasons, applicants submit that the rejection should be withdrawn from independent claims 6, 29, and 34, and from their dependent claims 20, 21, and 30-33.

c. Zerbo fails to disclose at least the element of “customer-defined identifying material”

All of the pending claims recite, in part, “*customer-defined identifying material*.” The Examiner asserts that

printed material (18) . . . further includ[es] customer-defined identifying material (*printed matter which is directed to configuration of the toy desired by the person that has the package*)

(page 3, lines 4-8) (emphasis in original). However, in light of the meaning of the term in view of the specification, the assertion that Zerbo discloses this limitation is erroneous.

As noted above, the specification supplies an abundant number of references to a customer’s provision of identifying material. For example, during component configuration, a customer may also input identifying information (page 14, lines 2-8) in addition to the selections of configurations of components. The identifying material may thus include customer-provided information such as a name for the toy as defined by the customer, the identity of an intended

recipient as defined by the customer, as well as the customer-selected component configurations (page 10, line 2).

In contrast, there is nothing about Zerbo's "printed material 18" that is selected, defined, or provided by a customer.

In Zerbo, reference number 18 refers to the front face of a card 16, which bears instructions for assembling the floral arrangement the kit is designed to replicate (Fig. 3; 3:12-13). The opposite face of card 16 bears a pictorial illustration 17 of the floral arrangement (Fig. 1; 2:60-64). The instructions and the pictorial representation of the finished floral arrangement are provided without regard to customer input. Indeed, since Zerbo's flower-arranging kit is mass-produced for general consumption, no opportunity is provided to a consumer to select configurations of components prior to manufacture and sale, or to otherwise provide information or define material as noted above. Instead, the pictorial representation, instructions, and other data on printed material 18 are generic and are not personalized to, nor defined by, a customer. Indeed, no material in the Zerbo kit is "customer-defined," as the term is consistently used throughout the specification.

Even assuming that the Examiner's urged interpretation of printed material 18 as "*printed matter which is directed to configuration of the toy desired by the person that has the package*" is consistent with Zerbo, this construction of the limitation "*customer-defined identifying material*" has no basis in the application as filed. As demonstrated above, the cited element of Zerbo is not "*customer-defined identifying material*."

Applicants presented this argument in a response to the first Office action dated October 22, 2001. The Examiner failed to address this argument in the second Office action, and instead cited another reference (Fleet) asserted to also disclose the element. In response to applicants'

modified argument that both Zerbo and Fleet fail to disclose “*customer-defined identifying material*,” the third Office action presented a third reference (U.S. Patent No. 5,370,223 to Leicht) asserted to disclose the element. As such, applicants submit that the Examiner has impliedly conceded that Zerbo fails to disclose this element. For at least the aforementioned reasons, applicants submit that the rejection should be withdrawn from all of the pending claims.

d. Zerbo fails to disclose at least the element of “*a customer-defined intended recipient*”

In each of the presently pending claims except independent claim 34, the customer-defined identifying material includes an indication of a “*customer-defined intended recipient*.” As discussed in detail above, Zerbo fails to disclose customer-defined identifying material or information. Thus, since the relevant claims indicate that a “*customer-defined intended recipient*” further limits “*customer-defined identifying material*,” Zerbo accordingly fails to disclose a “*customer-defined intended recipient*.”

Regardless of Zerbo’s failure to disclose “*customer-defined identifying material*,” the Examiner asserts that the intended recipient is “the person who purchases or receives the package in the particular desired configuration” (page 3, lines 12-13). However, there is no way to interpret this assertion to be consistent with the limitation as defined according to the specification. For example, if the Examiner’s assertion implies that the *customer* is the intended recipient, applicants note that Zerbo fails to provide any indication that the “printed material 18” of a kit does—or even can—include an identification of the individual who ultimately purchases or receives the kit. The Zerbo kit is mass-marketed and configured to provide a customer with a wide selection of floral arrangement kits; no opportunity is provided to the customer prior to manufacture or packaging in which the customer can indicate that he will purchase a specific kit

(or give it to someone else), nor does Zerbo disclose any manner in which such an indication is reflected in the material that accompanies the kit (e.g. “printed material 18”).

Moreover, the Examiner’s interpretation of the term “*customer-defined intended recipient*” has no basis in the application as filed. As discussed thoroughly above, “*customer-defined intended recipient*” refers to information provided by a customer prior to ordering a toy and thus, prior to its manufacture, delivery, and sale. Zerbo discloses no analogous feature, instead teaching a flower-arranging kit marketed to a customer whose only interaction with the product is subsequent to its manufacture and sale. Thus, for at least the aforementioned reasons, applicants submit that the rejection should be withdrawn from independent claims 6, 13, and 29, and their dependent claims 20-25, 27, 28, 30-33.

Thus, even assuming that the Examiner’s interpretation of “*customer-defined intended recipient*” is consistent with the limitation as set forth in the specification, Zerbo fails to disclose the product having customer-defined identifying material that includes the identity of the recipient.

e. Conclusion

For a reference to anticipate a claim under § 102(b), the reference must disclose each and every element of the claim.² The Zerbo disclosure, relied upon by the Examiner to support the § 102(b) rejection of independent claim 1, fails to disclose at least the four exemplary elements discussed above. The pending claims include independent claims 6, 13, 29, and 34. As demonstrated above, Zerbo fails to disclose the limitations “*toy*” and “*a personalized toy*” as recited in claims 6, 29, and 34; “*customer-defined identifying material*” as recited ion *all* of the pending claims, and a “*customer-defined intended recipient*” as recited in independent claims 6,

² *Verdegraal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

13, and 29. As such, applicants submit that the rejection is improper, and requests reversal of the rejection and allowance of the pending claims.

3. The Pending Claims Are Not Obvious Over Zerbo

All of the pending claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zerbo. The Examiner indicates that “Zerbo discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claims(s).” The Examiner then asserts either that “it would have been obvious ... to provide the customer-defined identifying material with an indication of a customer-defined intended recipient, a toy name, or a story” since such limitations only depend on the intended use of the assembly, or alternatively that when claimed printed matter is not functionally related to the substrate, the invention is not distinguished from the prior art in terms of patentability (page 5, lines 3-11).

In the paragraphs below, these assertions are addressed in the order presented in the Office action.

a. Zerbo fails to teach or suggest all of the elements of the rejected claims

Initially, applicant notes that Zerbo fails to disclose, teach, or suggest at least the several claim limitations presented previously, and thus fails to disclose “the claimed invention” except for the printed matter, as asserted in the Office action. For example, Zerbo fails to disclose at least the elements of “*toy*” and “*a personalized toy*” as recited in independent claims 6, 29, and 34, and the claims that depend therefrom. Since Zerbo fails to disclose all of the limitations of at least these claims, the rejections under § 103(a) should be reversed.

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- b. Zerbo does not contain any teaching or motivation to modify the subject matter of the reference to meet all of the limitations of the rejected claims

Responsive to the assertion that it would have been obvious to modify the customer-defined identifying material with indications of customer-defined intended recipient, toy name, and so forth, applicants note that Zerbo fails to disclose “*customer-defined identifying material*,” as demonstrated above. Since Zerbo fails to disclose the aforementioned limitation in the first place, it cannot be considered obvious to have modified the limitation as proposed by the Examiner.

Moreover, the Examiner’s assertion of the obviousness of modifying the customer-defined identifying material is improper: the limitation of “*customer-defined intended recipient*” is not an intended use, but rather is a structural and/or functional limitation. In light of the specification, the limitation “*customer-defined intended recipient*” indicates the result of a customer action performed during configuration of the personalized toy and prior to its manufacture, packaging, or delivery. The result of the customer action is then incorporated into the packaging of the personalized toy. As such, the limitation conveyed by the claim language “*customer-defined intended recipient*” must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used (MPEP § 2173.05(g)). In this regard, applicants note that the Examiner has previously, consistently treated this limitation as a structural and/or functional limitation (*see, e.g.*, first Office action of October 20, 2001, page 2; second Office action of April 24, 2002, page 2; third Office action of August 27, 2002, page 2; etc.). Thus, when properly considered as a limitation, it is clear that the § 103(a) rejection as presented in the Office action fails to render obvious the pending claims.

c. The rejection misconstrues the structural limitations of the rejected claims and incorrectly characterizes the relationship between the “printed matter” and the “substrate”

Responsive to the assertion that when claimed printed matter is not functionally related to the substrate, the invention is not distinguished from the prior art in terms of patentability, applicants initially note that only independent claim 6 (and claims 20 and 21 that depend therefrom) recite printed material, and thus submit that the rejection is improper with respect to the remaining claims.

Moreover, the Examiner indicates that the limitations “customer-defined intended recipient, a toy name, or a story” are being construed as “printed matter,” and the limitation “package insert” is being construed as the “substrate” (page 5, lines 17-19). However, the limitations do not appear in all of the rejected claims. More specifically, none of the limitations construed as “printed matter” are recited in claim 34, and *no* pending claim recites the structure “package insert.” For at least this reason, applicants submit that the rejection is improper with respect to *all* of the pending claims.

However, even assuming that the “printed matter” rejection is properly applied to all of the pending claims, the Examiner fails to demonstrate the *absence* of a functional relationship between the printed matter and the substrate. Instead, the Examiner indicates that the relationship of the substrate providing support for the printed matter is “not the kind of functional relationship necessary for patentability” (page 5, lines 15-16), citing *In re Gulack*, 703 F.3d 1381 (CAFC 1983) as support for the proposition. However, applicants note that this relationship, like the one discussed by the Court in *Gulack*, is not the only relationship between the substrate and the printed matter.

The contested claims in *Gulack* recited an endless band upon which is displayed a sequence of digits (*Id.* at 1386). The court found that, although one relationship of the band to the sequence of digits was that of the band providing support for the digits, another relationship existed: one in which each of the endless sequence of digits reside in a unique position with respect to every other digit in an endless loop (*Id.* at 1386-87). As such, the court found that the digits exploit the endless nature of the band—and this relationship was held to be a functional relationship (*Id.* at 1385).

Similarly, the limitation “*customer-defined intended recipient*” exploits the nature of the printed material: the latter is configured by the customer prior to the manufacture and packaging of the personalized toy, and is incorporated in the packaging of the toy. Thus, the relationship is a functional one. Further, the corresponding elements of Zerbo fail to include this relationship.

d. Conclusion

Applicants submit that the above discussion clearly demonstrates that the rejection of claims 6, 13, 20-25, and 27-34 under 35 U.S.C. § 103(a) was improper, and that all presently pending claims patentably distinguish the references of record. Therefore, applicants request that the Examiner’s rejection of the pending claims be reversed.

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IX. CLAIMS APPENDIX

1-5. (Canceled)

6. (Previously presented) A customer-defined, packaged, personalized toy, comprising:
a package having an aperture;
a personalized toy in the package; and
printed material, separate from the toy and further including customer-defined identifying material, supported on the package so that the identifying material is visible through the aperture of the package and where the identifying material includes a customer-defined intended recipient; wherein the aperture is smaller than the printed material.

7-12. (Canceled)

13. (Previously presented) A package for displaying a personalized toy, the package comprising:
a flap, separate from the toy and having an inside and an outside, where the inside of the flap faces the personalized toy;
an aperture in the flap; and
customer-defined identifying material separate from the flap and supported on the inside of the flap, wherein the customer-defined identifying material includes a customer-defined intended recipient.

14-19. (Canceled)

20. (Previously Presented) The packaged toy of claim 6, wherein the identifying material includes a customer-defined toy name.

21. (Previously Presented) The packaged toy of claim 6, further comprising a toy-support card to display the personalized toy within the package.

22. (Previously Presented) The package of claim 13, wherein the customer-defined identifying material has a front side and a back side, wherein the front side of the material is visible through the aperture on the outside of the flap and the back side is visible on the inside of the flap.

23. (Previously Presented) The package of claim 13, wherein the customer-defined identifying material includes a customer-defined toy name.

24. (Previously Presented) The package of claim 13, wherein the identifying material includes a story related to the personalized toy.

25. (Previously Presented) The package of claim 13, wherein the inside of the flap includes tabs configured to support the identifying material on the inside of the flap.

26. (Canceled)

27. (Previously Presented) The package of claim 13, wherein the identifying material is removable.

28. (Previously Presented) The package of claim 27, wherein the personalized toy is visible through the aperture when the identifying material is removed.

29. (Previously presented) A packaged toy, comprising:
a personalized toy;
customer-defined identifying material separate from the toy and adapted to be customized according to specifications created by a customer, the customer-defined identifying material including an indication of a customer-defined intended recipient; and
a package enclosing the personalized toy and the customer-defined identifying material;
wherein the package has a flap covering at least a portion of the personalized toy and being adapted to support the customer-defined identifying material, with at least a portion of the identifying material visible from the exterior of the package.

30. (Previously presented) The packaged toy of claim 29, wherein the flap includes an aperture adapted to expose the personalized toy when the identifying material is removed.

31. (Previously presented) The packaged toy of claim 29, wherein the flap is adapted to be opened to reveal the personalized toy.

32. (Previously presented) The package of claim 29, wherein the customer-defined identifying material includes a customer-defined toy name.

33. (Previously presented) The packaged toy of claim 29, further comprising a toy-support card to display the personalized toy within the package.

34. (Previously presented) A customer-defined, packaged, personalized toy, comprising:

a package;

a personalized toy in the package;

customer-defined identifying material, separate from the toy and supported on the package;

an aperture in the package positioned so that at least a portion of the identifying material is visible through the aperture of the package;

wherein the visible portion of the identifying material blocks the aperture, preventing the viewing of the personalized toy from the exterior of the package.

X. EVIDENCE APPENDIX

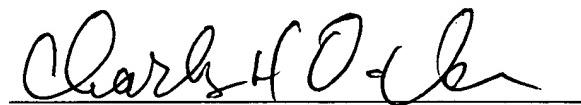
None presented.

XI. RELATED PROCEEDINGS APPENDIX

None presented.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Charles H. DeVoe
Registration No. 37,305
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Appellants



CERTIFICATE OF MAILING

I hereby certify that this correspondence (in triplicate), the attached transmittal, fee transmittal and a check in the amount of \$950 are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on October 28, 2005.

Stephen R Pendleton
Stephen R. Pendleton